

03-09-05

Handwritten: #7, DAC, \$

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Smith

Examiner: Hoang Nguyen

Application number: 09/698,929

Art Unit: 3748

March 5, 2005

TITLE: RENEWED PETITION UNDER 37 C.F.R. 1.137 (b)

Attention: OFFICE OF PETITIONS

Re Notice of dismissal of Petition to Revive Application Abandoned Unintentionally signed by John Gillon and mailed Feb. 28, 2005, (copy enclosed)

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OFFICE OF PETITIONS

Sir:

The Applicant respectfully requests reconsideration of the referenced Notice of Dismissal of the Petition.

The notice of dismissal of petition stated that the petition filed 29 Dec. 2004 failed to include the fee requirement of the petition. Since the original submission included a check for \$ 685.00, it is believed that the balance due is \$65.00. Please find enclosed check number 474 for the amount \$ 65.00.

The application was abandoned after midnight 5 September 2001 for failure to respond to an Office Action mailed 5 June 2001. The failure to respond was unintentional.

Respectfully submitted,

*Robert Samuel Smith*

Robert Samuel Smith

I certify that I have placed this document in an envelope addressed to the Commissioner of Patents and deposited it with the United States Postal Service on 3-7-5 certificate number EV 500079065 US

*R. Smith*

Adjustment date: 03/10/2005 YPOLITE1  
01/03/2005 JADD01 00000039 09698929  
01 FC:1999 -685.00 OP

03/10/2005 YPOLITE1 00000058 09698929

01 FC:2453

750.00 OP



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No: \_\_\_\_

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FEB 28 2005  
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In re Application of  
Smith  
Application No. 09/698,929  
Filing Date: 26 October, 2000  
Attorney Docket No. RS50

This is a decision on the petition filed on 29 December, 2004, to revive the instant application 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

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The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on June 5, 2001, with reply due absent extension of time on or before 5 September, 2001;
- the Application went abandoned after midnight 5 September, 2001;
- the Office mailed a Notice of Abandonment on 5 April, 2002;
- with the instant petition (in which Petitioner failed to complete (*i.e.*, sign and date) the certificate of mailing under 37 C.F.R. §1.8), Petitioner tendered \$685.00 and, thus, Petitioner failed to pay the full fee under the regulation (see: <http://www.uspto.gov/web/offices/ac/qs/ope/fee2005feb01.htm> for the current fee and ensure that fees are accompanied by a completed (*i.e.*, signed and dated) certificate of mailing under 37 C.F.R. §1.8), in addition to the reply and statement of unintentional delay.

The fee is jurisdictional. Therefore, the substance of the petition cannot be addressed until the fee requirement under the regulation is satisfied. (Petitioner also should ensure that any renewed submission satisfies not only the "fee" requirement, but also the "reply" and "statement/showing" requirements under the regulation.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

#### Allegations as to Unintentional Delay

A grantable petition under 37 C.F.R. §1.137(b) requires a petition, fee, statement of unintentional delay, reply, and a terminal disclaimer and fee if appropriate.

As indicated above, Petitioner has failed to satisfy at least the "fee" requirement of the regulation.

#### CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail:       Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

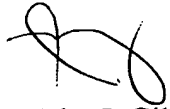
<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

By FAX: IFW Formal Filings  
(703) 872-9306  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions